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10/046,997	01/16/2002	Michael Wayne Brown	AUS920010746US1	6351
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EXAMINER				
BARTLEY, KENNETH				
ART UNIT		PAPER NUMBER		
3693				
NOTIFICATION DATE		DELIVERY MODE		
07/22/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

### Office Action Summary

**Application No.**

10/046,997

**Applicant(s)**

BROWN ET AL.

**Examiner**

KENNETH L. BARTLEY

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2009 has been entered.

### ***Response to Amendment***

2. Claims 1-6 have been amended. Claims 7-20 have been canceled. Claims 21-34 are new. Claims 1-6 and 21-34 are pending in the application and are provided to be examined upon their merits.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-6 and 21-34 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner thanks the Applicant for their detailed response. The 35 USC § 112, 2<sup>nd</sup> paragraph rejections from the prior Office Action are withdrawn. However, a

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new 35 USC § 112, 1<sup>st</sup> paragraph rejection is provided. The prior art response is no longer applicable based on the new cited prior art.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6 and 21-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, for example has "associating a transaction account with a set of communication devices..." where there is no teaching of "transaction account" associated with communication devices in the application. A transaction is usually associated with an account (e.g. a transaction is made against a bank checking account) and is not itself an account (i.e. a transaction account). There is likely a transaction number to identify a specific transaction, or an account of some type associated with a transaction, but not an account. Claims 23 and 29 have a similar problem. It is noted that a device ID may be associated with a communication device (Fig. 1, ref. 112)

Claim 1, for example has "associating a home address with a given identification number..." where "home address" is not taught in the specification. The specification teaches a home. If the "location" of a store was indicated by an address in the specification, the "home address" would be permitted. There appears to be no teaching in the specification as to what a "location" means or how it is defined. Claims 23 and 29 have a similar problem.

Claim 2 has "comparing of the location.... is performed by an account service provider" where there is no teaching of an account service provider comparing locations. From the instant application:

"The point of sale terminal 102, contacts a transaction service provider or central computer 104, typically via a telephone call. When the phone call is connected, the point of sale terminal 102 initializes communication with the service provider central computer 104. The service provider typically validates the transaction card. This may include checking with the actual card issuer to make sure the proposed procurement would not exceed predetermined maximum purchase limits." ([0024] of Pub No US 2003/0135463)

Claims 23 and 29 have similar problems.

For examination purposes, this is interpreted to mean associating a device ID with a communication device.

Claims 2-6, 21-22, 24-28, and 30-34 are rejected because they depend from their respective independent claims.

***Examiner Request***

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6. The Applicant is requested to indicate where in the specification there is support for amendments to claims should Applicant amend. The purpose of this is to reduce potential 35 U.S.C. §112, 1st paragraph issues that can arise when claims are amended without support in the specification. The Examiner thanks the Applicant in advance.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 21-34 rejected under 35 U.S.C. 102(e) as being anticipated by Patent No. US 6,868,391 to Hultgren.

**[Note that the analysis for the method claims (1-6) also applies to the respective system claims (23-28) and product claims (29-34).]**

Regarding claims 1, 23, and 29:

(claim 1). A computer implemented method for authorizing transactions against an account for a transaction occurring over an internet site, the computer implemented method comprising:  
associating a transaction account with a set of communication devices;

**Hultgren teaches:**

**Internet...**

**"FIG. 1 shows telepay TSN 30 as also being connected by a data network N to a customer financial institution 80 and a merchant financial institution 90. Although illustrated separately, it should be understood that network N**

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can be included in PSTN 50. Moreover, a variety of protocols (e.g. X.25, X.21, leased line and TCP/IP, or internet/TCP/IP) can be utilized over network N." (col. 3, lines 59-65)

Set of devices...

"Although customer wireless communication unit 60 is hereinafter illustrated as being a mobile telephone, it should be understood that other types of devices are also contemplated for use with the invention, such as a personal digital assistant (PDA) with a radio connection to PSTN 50 or a computer with mobile termination capabilities." (col. 3, lines 49-54)

An account number with a communication device...

"Further, the SIM (subscriber identification mobile) card utilized by customer mobile station 60 of the present invention can also serve as a credit card, in which case payment can be debited to the customer's credit card account or telephone bill. In this regard, the SIM card has the customer's account number stored therein, which account number can be automatically communicated by customer mobile station unit 60 to telepay TSN 30." (col. 12, lines 66-67 and col. 13, lines 1-6)

storing the set of communication devices with a set of corresponding identification numbers in a database for the transaction account, wherein each communication device from the stored set of communication devices is adapted to transmit a physical location of the each communication device;

Storing...

"As another simple but less accurate example, TSN 30 can interrogate the mobile network subscriber database (e.g. a home location register [HLR] in GSM) to inquire as to which MSC and which radio base station is handling the customer's mobile station 60 to determine where customer mobile station 60 is located." (col. 11, lines 56-62) Inherent with mobile network subscriber database to determine customer's mobile station is an identification number of the mobile device.

Physical location of communication device...

"The TSN has access to prestored GPS location coordinates of the merchant terminal, and receives the current GPS coordinates of the customer mobile station from the customer mobile station." (col. 2, lines 20-23)

associating a home address with a given identification number for a single communication device, wherein the home address corresponds to the home address of a user on the transaction account, and wherein the single communication device is one of the stored set of communication devices;

Home (native location) address...

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"In another mode, the customer can be at a customer predetermined native location, e.g., at the customer's home or place of business, where the customer views a merchant's web page." (col. 2, lines 8-11) Inherent with location of a home is a home address.

GPS storage of home address (native location)...

"FIG. 2A shows an embodiment of telepay TSN 30A(1)suitable for the second mode of the invention, i.e., the mode illustrated in FIG. 5B and in FIG. 5C in which the customer's mobile station is at customer's predetermined native location. The telepay TSN 30A(2) of FIG. 2A resembles that of FIG. 2 but in addition includes transaction security module 212B. Further, customer data base 222 of FIG. 2A contains an additional field for each customer record, particularly a field 222D. Field 222D has prestored therein one or more sets of customer location (GPS) coordinates, e.g., the coordinates of the customer's predetermined native location(s)." (col. 10, lines 59-67 and col. 11, lines 1-3)

Associate home address with id number....

"At step 308B of FIG. 4B, transaction security module checks whether customer mobile station 60 is within a predetermined geographical proximity of a registered customer predetermined native location. In particular, transfer communication module 206 passes to transaction security module 212 the customer GPS location coordinates obtained at step 306 and the current GPS coordinates of customer mobile station 60." (col. 11, lines 11-18) Inherent with comparing a customer mobile station with a home (native) location is an identification number.

receiving a transaction request for the transaction occurring on the internet site, wherein the transaction request comprises an account number associated with the transaction account;

obtaining a location of the single communication device;

Transaction request and account number...

"Further, the SIM (subscriber identification mobile) card utilized by customer mobile station 60 of the present invention can also serve as a credit card, in which case payment can be debited to the customer's credit card account or telephone bill. In this regard, the SIM card has the customer's account number stored therein, which account number can be automatically communicated by customer mobile station unit 60 to telepay TSN 30." (col. 12, lines 66-67 and col. 13, lines 1-6)

comparing the location of the single communication device with the location of the home address; and

"At step 308B of FIG. 4B, transaction security module checks whether customer mobile station 60 is within a predetermined geographical



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proximity of a registered customer predetermined native location. In particular, transfer communication module 206 passes to transaction security module 212 the customer GPS location coordinates obtained at step 306 and the current GPS coordinates of customer mobile station 60. Transaction security module 212 then compares the customer GPS location coordinates obtained at step 306 and the current GPS coordinates of customer mobile station 60.” (col. 11, lines 11-18)

responsive to detecting a match between the location of the single communication device with the location of the home address, authorizing the transaction occurring over the internet site.

“With the transaction approved by both parties, at step 344 transfer coordination module 206 directs the funds transfer authorization module 210 to authorize initiation of transfer of the transaction amount from the customer account to the merchant account. Along with this directive, funds transfer authorization module 210 is provided the transaction code, the transaction amount, the customer financial institution address, the customer account identifier, the merchant financial institution address, and the merchant account identifier.” (col. 8, lines 66-67 and col. 9, lines 1-7)

Regarding claims 2, 24, and 30:

(claim 2) The computer-implemented method of claim 1, wherein the comparing of the location of the single communication device with the location of the home address is performed by an account service provider.

Hultgren teaches:

“For the embodiment shown in FIG. 2, customer database 222 has prestored therein a record for each customer who subscribes to the telepay service offered by telepay TSN 30. The record for each customer has at least three fields, including a customer identifier field 222A; a customer financial institution address field 222B; and, a customer account identifier field 222C.” (col. 5, lines 53-59)

Regarding claims 3, 25, and 31:

(claim 3) The computer-implemented method of claim 1, wherein the each communication device from the set of communication devices comprise a global positioning system device.

Hultgren teaches:

“The system of FIG. 1A differs from that of FIG. 1 e.g., in that customer mobile station 60 includes a GPS (global positioning system) communication transponder 62. GPS transponder 62 serves to interrogate a GPS satellite 100 and to obtain therefrom a GPS response which indicates the current GPS coordinates of customer mobile station 60.” (col. 9, lines 48-53)

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Regarding claims 4, 26, and 32:

(claim 4) The computer-implemented method of claim 1 wherein the set of corresponding identification numbers comprise a telephone number associated with each communication device.

Hultgren teaches:

**"If telepay TSN 30 is a SCP-type node, the SSP obtains the mobile number (CLI) via the network signaling (e.g., ISUP or TUP protocols according to ITU standards) and sends the CLI to the SCP via the INAP protocol. Thus, telepay TSN 30 does not have to interrogate the customer mobile unit 60 for its account number." (col. 13, lines 44-49)**

Regarding claims 5, 27, and 33:

(claim 5) The computer-implemented method of claim 1, wherein the single communication device is a mobile phone.

Hultgren teaches:

**"Although customer wireless communication unit 60 is hereinafter illustrated as being a mobile telephone, it should be understood that other types of devices are also contemplated for use with the invention, such as a personal digital assistant (PDA) with a radio connection to PSTN 50 or a computer with mobile termination capabilities." (col. 3, lines 48-54)**

Regarding claims 6, 28, and 34:

(claim 6) The computer-implemented method of claim 1, further comprising:

determining whether the transaction is within a predefined credit limit.

Hultgren teaches:

**"Many consumer-based commercial transactions involve payment using a credit card or bank debit card. In the course of such transactions, a computerized "cash register" terminal or the like is connected by a telecommunications link to a financial institution (e.g., a bank or credit card company which sponsors the card) for the purpose of obtaining an authorization or indication that the consumer's account balance is sufficient to cover the cost of the particular transaction." (col. 1, lines 21-38)**

**"The TSN of the invention also optionally provides an authorization assurance feature and a security feature. For authorization assurance, prior to requesting a funds transfer from the customer account in the amount of the transaction amount, the TSN checks whether the customer financial institution will authorize such funds transfer." (col. 1, lines 65-67 and col. 2, lines 1-3)**

Regarding claim 21:

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The computer-implemented method of claim 1, wherein the transaction occurring on the internet site is for goods or services.

**Hultgren teaches:**

**"In accordance with the present invention, a customer who operates customer mobile station 60 seeks to purchase goods or services from a merchant." (col. 4, lines 13-15)**

**Regarding claim 22:**

The computer-implemented method of claim 1, wherein the user on the transaction account associated with the home address provides a unique code during the transaction.

**Hultgren teaches:**

**"As one example, in the manner illustrated in FIG. 5B, at home a customer on computer 64 may reach the Web page of a utility company in order to pay, for example, a utility bill. By entering the customer's name or account number with the utility company (and possibly a PIN or the like for security reasons), the customer is linked to a display of the customer's present utility bill. The display provides the transaction amount (current balance due), as well as a merchant identifier and possibly a transaction code. The customer then dials the Telepay TSN number using the customer's mobile station 60, and in response to prompts enters e.g., the merchant identifier and transaction amount (and possibly the transaction code)." (col. 14, lines 12-24)**

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20020023010 A1	US-PGPUB	Rittmaster et al.
US 20020023215 A1	US-PGPUB	Wang et al.
US 20020174062 A1	US-PGPUB	Sines et al.
US 20030135463 A1	US-PGPUB	Brown et al.
US 20040205194 A1	US-PGPUB	Sahai
US 6157935 A	USPAT	Tran et al.
US 6370629 B1	USPAT	Hastings et al.

<b>US 6985588 B1</b>	<b>USPAT</b>	<b>Glick et al.</b>
<b>US 7143289 B2</b>	<b>USPAT</b>	<b>Denning et al.</b>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH L. BARTLEY whose telephone number is (571)272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAGDISH N PATEL/  
Primary Examiner, Art Unit 3693